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10/761,401	01/22/2004	Ola Olofsson	TPP 31436DIV	3311
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EXAMINER				
SELF, SHELLEY M				
ART UNIT		PAPER NUMBER		
3725				
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10/15/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/761,401

## Applicant(s)

OLOFSSON, OLA

## Examiner

Shelley Self

## Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed July 11, 2008 is insufficient to overcome the rejection of claims as set forth in the last Office action and an action on the merits follows.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as noted in the previous Office Action (1/11/08). It is not clear what the "characteristic surface of a milled surface" and the "characteristic surface of a broached surface" are. Applicant is required to positively recited, and clearly defined the claimed invention. What is the characteristic? Examiner notes that characteristic as defined by Merriam Webster On-Line Diction is understood as, "a distinguishing trait, quality or property". With this understanding it is not clear what Applicant is claiming as the "characteristic". Appropriate correction is required to facilitate a clear understanding of the claimed invention and proper application of the prior art. Claim 32 as presently presented is not deemed allowable.

### ***Claim Rejections - 35 USC § 102/ Claim Rejections - 35 USC § 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 27-31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Moriau et al. (6,006,486). Claims 24 and 27-31 are rejected as noted in the previous Office Action (1/11/08). Moriau discloses a floor comprising a first board comprising an edge, the edge comprising a tongue (9); a second board comprising an edge, the edge comprising a groove, the groove defined by an opening (81) in the edge and an inner most portion; the groove further comprising a depression (fig. 23) positioned in a portion distal the innermost portion wherein the first and second boards are joined by the tongue and grooves.

As to the recitation, "...the broached portion having angles sharper than possible by milling", (clm. 28) this is treated as a product-by-process limitation, as, the claim positively defines either the tongue or groove to have both milled and broached portions and the tongue and groove to form a joint. Examiner notes that either the tongue or groove, having a broached portion having angles sharper than possible by milling, does not positively define an end resultant product, i.e. surface comprised of a plurality of boards having a joint connection between the boards that is patentably distinct from the prior art of record. Further examiner notes the process by which the end result product (surface comprised of plurality of boards having a joint connection between the boards) is made is not germane to the patentability of the end resultant product.

Regarding claims 24, 27-30 and 33, Examiner notes, *“wherein at least one of the tongue and groove comprise both a milled and a broached portion”*, *“the groove comprises both milled and broached portions”*, *“wherein the polymeric material is an extrudate before being milled”*, *“wherein at least one of the tongue and the groove is formed by broaching an impregnated milled portion”*, *“wherein at least one of the tongue and the groove comprising a burr-free broached portion”*, *“wherein at least one of the tongue and groove comprise a broached portion...not capable of being formed by milling”* and *“the surface created by a rotating milling tool...the surface of the grooves shows a smoother surface than that made by the rotating milling tool, the smoother surface formed by a broaching tool”* to be product-by-process limitations.

Accordingly, because Serino clearly discloses a (product) first and second boards having a tongue and groove joint, the process by which the tongue and groove of the boards is formed into a joint (i.e., milled, broached, sharp angles, burr-free & geometry not capable of being formed by milling) or extrusion before milling are not germane to the patentability of the claimed invention. Additionally, the claimed end resultant product (at least two boards having a tongue and groove joint/connection to create a surface) does not patentably distinguish over the prior art of record.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Additionally claims 24, 27-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriau et al. (6,006,486). Claims 24 and 27-31 are rejected as noted in the previous Office Action (1/11/08). As noted above, the claims are deemed product-by-process

claims, therefore, the process (broaching, milling) by which the end resultant product of a floor is created is not germane to the patentability of the product. Even though product-by-process claims are limited by and defined by the process, determination of patentability is *based on the product itself*; therefore the floor. The patentability of a product does not depend on its method of production. If the product in the product-by-process claims is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698 227 USPQ 964, 966 (Fed. Cir. 1985)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-23, 25 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriau et al. (6,006,486) in view of Serino et al. (6,357,197) as noted in the previous Office Action (1/11/08). With regard to claims 21 and 23, Moriau does not disclose the tongue and groove comprise a milled polymeric material, the polymeric . Serino discloses the tongue and groove both to comprise a polymeric material. Examiner notes the adhesive (19) between the tongue and groove to be a polymeric material because it consists of a thermoplastic. Applicant's disclosure states an admitted prior art that, thermoplastic is a type of polymeric material. Accordingly because Serino discloses board (17) to be comprised of a thermoplastic material and

use of an adhesive that is also a thermoplastic material, Serino anticipates a tongue and groove comprised of polymeric material.

With regard to claim 22, Serino discloses the tongue (16) to be glued (18) to the groove/board (13). Accordingly it would have been obvious to the skilled artisan to construct Moriau such that the tongue is glued to the groove for efficiently securing the tongue and groove joint as taught by Serino.

With regard to claim 23, Serino discloses a polymeric material (col. 3, lines 35-50), Examiner notes a thermoplastic polymer to be a polymer material.

With regard to claims 25 and 34, Moriau and Serino disclose wherein at least one of the first board and the second board comprises a core, the core being formed from wood medium density or high density fiber board (Moriau col. 3, lines 14-17, 35-37).

### ***Response to Arguments***

Applicant's arguments filed July 11, 2008 have been carefully considered but they are not deemed persuasive. Applicant states that, "Applicants have positively recited...the subject matter which the Applicant regards as his invention". Applicant further argues that the Applicants pointed out in page 4 of the specification, what they regard as the characteristics of a milled surface and what they regard as a characteristic of a broached surface. Examiner notes that although the claims are read in light of the specification, limitation and/or structure (i.e., exactly what the milled/broached surface characteristics are) specifically defined in the disclosure/specification are not read into the claimed invention. Therefore the 35 U.S.C. 112 2<sup>nd</sup> paragraph rejection of claim 32 is proper and stands.

In response to the 35 U.S.C 102 and 103 rejections noted in the previous Office Action 1/11/08), Applicant filed a 1.132 declaration stating that

Applicant argues that the Declarant is familiar with the invention and further argues that the Declarant presents proof that the limitation of the claims positively define the structure of the product, i.e., by reference to an angle in the tongue or grooves which cannot be made by milling. Accordingly, Applicant argues that the Examiner is incorrect in alleging that the Moriau product expressly and/or inherently anticipates the claimed invention. This however is not deemed persuasive. As stated previously, the claims are product-by-process claims because the claims are drawn to a floor, the floor merely comprises boards having tongue and groove joints that are connected to construct the floor, i.e. the angles of the tongue and groove joints of the finished product (floor) are not distinguishable from any tongue and groove joint when the board are connected to construct the end resultant floor. As noted above, claims are deemed product-by-process claims and accordingly the process or processes, i.e., milling, broaching sawing etc...by which the end resultant product of a floor is created are not germane to the patentability of the product, i.e., the floor. Examiner further notes the process steps of creating or producing the floor (an product) in the absence of any positively recited patentably distinguishing end resultant structure to the floor (product) do not in an of themselves lend to patentability of the product. The claims as written are drawn to a product, a floor having structural limitations including at least two boards each including a tongue and a groove, such that the tongue of one board is matable with the groove of the other board so as to create the floor or system.

Examiner concedes there may be differences in how the angles of the tongue and groove of the claimed invention are constructed over that of how the prior art Moriau or Scrino are



constructed; however the end resultant floor/system of the claimed invention is not patentably distinguished over either Moriau or Serino because limitations to the process by which a product (floor) is made or manufactured are not given patentable weight. To merely state, "a broached potion having an angle sharper than possible by milling", is directly drawn to the processing of the board(s) of the floor, i.e., broaching versus milling. No angle of the end resultant product, i.e., floor, is structurally defined. For example, because the end result is the floor which comprises at least two boards wherein one board includes a groove the other a tongue such that the tongue is matable with the groove; the end resultant product, i.e., floor is both boards joined via the tongue of one board and the groove of the other and when finished, i.e., constructed into the floor (the boards are mated) there is no patentably distinguishable difference between the floor of the claimed invention and that of the prior art, Moriau.

Examiner further notes method or process claims encompassing the process by which the floor is constructed, i.e., "a broached potion having an angle sharper than possible by milling" would be given patentable weight. Accordingly the rejections in view of Moriau and Serino are proper and stand.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is 571-272-4524. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shelley Self/  
Primary Examiner, Art Unit 3725

SS  
October 13, 2008

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